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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------|------------------------|
| 10/816,705   | 04/02/2004  | Cary Lee Bates       | RO919990202US2             | 1201                   |
| 31647 7590 09/28/2007<br>DUGAN & DUGAN, P.C.<br>55 SOUTH BROADWAY<br>TARRYTOWN, NY 10591 |             |                      | EXAMINER<br>ZHONG, JUN FEI |                        |
|  |             |                      | ART UNIT<br>2623           | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/28/2007    | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/816,705

Applicant(s)

BATES ET AL.

Examiner

Jun Fei Zhong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. This application appears to be a division of Application No. 09/503,888, filed 02/15/2000. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 04/02/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

3. The drawings are objected to because Fig. 1-12 are not of sufficient quality to permit examination. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the

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replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: remotely control set top box through telephone line.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. Sec. 101. Certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of

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matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. Sec. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 14 recites a computer program product, which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 8, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by August et al. (Patent # US 5671267).

As to claim 1, August discloses a method of controlling a set top box comprising:

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providing a set top box that can be controlled by a telephone line coupled to the set top box (e.g., the base unit 20 could be contained in the set top box 32) (see col. 9, lines 47-55; col. 10, lines 20-25, 45-65; Fig. 5);

receiving a telephone call from a calling party via the telephone line (see col. 10, lines 45-65);

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call (see col. 10, lines 45-65).

As to claim 12, August discloses an apparatus adapted to employ a telephone interface (e.g., set top box 32; Fig. 5) comprising:

a processor (e.g., control unit 210; Fig. 2) comprising computer program code adapted to control a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call (e.g., the base unit 20 could be contained in the set top box 32) (see col. 9, lines 47-55; col. 6, lines 35-51; col. 7, lines 1-11)

As to claim 14, it contains the limitations of claim 1 and is analyzed as previously discussed with respect to claim 1 above.

As to claim 2, August discloses the method of claim 1 wherein controlling the set top box via at least one command transmitted by the calling party comprises receiving

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at least one predetermined number dialed by the calling party (e.g., number 0-9 for channel number) (see col. 8, lines 13-17; col. 10, lines 59-65; Fig. 3).

As to claims 3 and 4, August discloses the method of claim 1 wherein controlling the set top box comprises disabling and enabling the set top box (e.g., user can remotely enable or inhibit channels or signals reaching video receiving device 60; Fig. 5) (see col. 10, lines 59-65).

As to claim 5, August discloses the method of claim 1 wherein controlling the set top box comprises directing the set top box to decrease a volume of a television set coupled to the set top box (see col. 2, lines 56-64).

As to claim 8, August discloses the method of claim 1 wherein controlling the set top box comprises directing the set top box to tune to a television event (see col. 10, lines 59-65).

As to claim 13, claim 1 meets the limitation.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Doganata et al. (Patent # US 6772436 B1).

As to claim 6, note the discussion above, August does not disclose using the television speaker for telephone speaker.

Doganata discloses the set top box to transmit an audio signal from the calling party over a speaker of the television set (see col. 4, lines 54-67; Fig. 1 and 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to using television speaker for telephone as taught by Doganata to the remotely control set top box of August because it enables TV viewers to participate in audio conferences that are linked to the programs that they are watching, without the need to dial in to a conference call (see col. 2, lines 15-18)

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Ellis et al. (Pub # US 2005/0028208 A1).

As to claim 7, note the discussion above, August does not disclose playing the television audio over the telephone.

Ellis discloses directing the set top box to play at least an audio portion of a television event over the telephone line (see paragraph 0094, 0133; Fig.1).



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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to play television audio as taught by Ellis to the remotely control set top box of August because it provides a program guide system that allows a user to adjust to the user settings of a plurality of program guides at different locations within a household from a single location (see paragraph 0013).

11. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Schuchman et al. (Patent # US 5640453).

As to claim 9, note the discussion above, August does not disclose directing the set top box to record a television event.

Schuchman discloses controlling the set top box comprises directing the set top box to record a television event (see col. 3, lines 29-36; Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control VCR through set top box as taught by Schuchman to the remotely control set top box of August because the subscriber's set-top box could command storage devices to record video services and a controlled data stream from the storage device (see col. 2, lines 38-42)

As to claim 10, Schuchman discloses the method of claim 9 wherein directing the set top box to record a television event comprises directing the set top box to transmit a record command to a video recording device (see col. 3, lines 29-36).

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12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Brodigan (Patent # US 6219355 B1).

As to claim 11, note the discussion above, August does not disclose directing the set top box to play a telephone message.

Brodigan discloses controlling the set top box comprises directing the set top box to play a telephone message previously recorded by the set top box (e.g., replay voice messages) (see col. 5, lines 31-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide voice message as taught by Brodigan to the remotely control set top box of August because provide a much needed simplification of services, such as a customer may review voice messages, or even order an additional telephone line or change phone services with their set top box (see col. 2, lines 55-65).

### ***Inquiries***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jun Fei Zhong whose telephone number is 571-270-1708. The examiner can normally be reached on Mon-Fri, 7:30-5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFZ  
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